# IAP7 Rec'd PCT/PTO 16 JUN 2006

PTO/SB/21 (09-04)
Approved for use through 07/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE and to a collection of information unless # displays a united 1/19.

Under the Paperwork	Reduction Act of 1995, no pers	ons are required to res	Application Number	10/533,848-Conf. #7896
TRANSMITTAL FORM (to be used for all correspondence after initial filing)			Filing Date	May 4, 2005
			First Named Inventor	
			Art Unit	Hélène Bouilloux-Lafont
			Examiner Name	Not Yet Assignend
				Not Yet Assigned
Total Number of Pages in This Submission			Attorney Docket Number	11345/063001
	EN	CLOSURES	(Check all that appl	(y)
Fee Transmittal Form		Drawing(s)		After Allowance Communication to TC
Fee Attached		Licensing-related Papers		Appeal Communication to Board of Appeals and Interferences
Amendment/Reply		Renewed Petition Under 37 C.F.R. § 1.47(a)		Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
After Final		Petition to Convert to a Provisional Application		Proprietary Information
Affidavits/declaration(s)		Power of Attorney, Revocation Change of Correspondence Address		Status Letter
Extension of Time Request		Terminal Disclaimer		X Other Enclosure(s) (please Identify below):
Express Abandonment Request		Request for Refund		Declaration by Frédérique Dersoir Certificate of Express Mailing
Information Disclosure Statement		CD, Number	of CD(s)	Return Receipt Postcard
Certified Copy of Priority Document(s)		Landso	cape Table on CD	
Reply to Missing Parts/ Incomplete Application		Remarks		
	to Missing Parts under FR 1.52 or 1.53			
37 0	FR 1.32 01 1.33			
	SIGNATI	JRE OF APPLICA	ANT, ATTORNEY, OR	AGENT
Firm Name OSHA · LIANG LLP				
Signature	ass			
Printed name	Jonathan P. Osha			
Date	June 16, 2006		Reg. No.	33,986
				Manalegal Sept.
157716				*O <sub>1</sub>
,5//10				



#### IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Hélène Bouilloux-Lafont et al. Confirmation No.: 7896

Application No.: 10/533,848 Art Unit: Not Yet Assigned

Filed: May 4, 2005 Examiner: Not Yet Assigned

For: SELECTING ADVERTISEMENT ON A SET TOP BOX IN A TELEVISION NETWORK

## RENEWED PETITION UNDER 37 CFR § 1.47(a)

MS PCT

Attn: Examiner Bryan Tung Office of PCT Legal Administration Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450

#### Dear Sir:

In response to the Decision on Petition mailed March 17, 2006, please consider the following renewed petition.

A petition under 37 C.F.R. § 1.47(a) requires (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the non-signing joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in § 1.17(i), and (4) the last known addresses of the non-signing inventors. Items (1), (3), and (4) have been satisfied by the previously submitted petition that is of record in the file. (See Decision of Petition mailed March 17, 2006). Accordingly, this renewed petition addresses item (2).

This renewed petition, taken with the previously submitted Declaration by Isabelle Thibaudeau, satisfies element (2) by setting forth the facts surrounding the diligent attempts made to contact the non-signing inventors via both regular postal mail and via electronic mail through the inventors' former employer.

U.S. Patent Application Serial No. 10/533,848 Attorney Docket No. 11345/063001; CPT02020

The required diligence is evidenced by the attached Declaration of Frédérique

Dersoir, who is a person with first-hand knowledge of the factual events outlining the

attempts made to obtain the non-signing inventors' signed Declarations. Frédérique

Dersoir's Declaration establishes that inventors Franck Bachet and Axel Taldir are

uncooperative and that inventor Hélène Bouilloux-Lafont is unreachable.

Conclusion

Applicant believes that this renewed petition addresses all outstanding issues

raised in the Decision on Petition mailed on March 17, 2006. In light of the petitioner's

diligent attempts to obtain the signature of the inventors via both regular postal mail and

a current/former employer, and, pursuant to 37 C.F.R. § 1.47(a), the petitioner requests

that the referenced application be examined without the signed Declarations of Hélène

Bouilloux-Lafont, Franck Bachet, and Axel Taldir.

While we believe that no fee is due with this renewed petition, if any fees are due,

please apply any charges not covered, or any credits, to Deposit Account 50-0591

(Reference Number 11345.063001).

Respectfully submitted,

Date: June 16, 2006

Jonathan P. Osha, Reg. No. 33,986

Osha • Liang, LLP

One Houston Center, Suite 2800

1221 McKinney Street

Houston, TX 77010

Telephone: (713) 228-8600

Facsimile: (713) 228-8778

Attachment: Declaration by Frédérique Dersoir

133469 2

2

Docket No.: 11345/063001

(PATENT)

#### IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of: Helene Bouilloux-Lafont

Confirmation No.: 7896

Application No.: 10/533,848

Art Unit: N/A

Filed: May 4, 2005

Examiner: Not Yet Assigned

For: SELECTING ADVERTISEMENT ON A SET TOP BOX IN A TELEVISION NETWORK

# **DECLARATION BY FRÉDÉRIQUE DERSOIR**

1. I, Frédérique Dersoir, am an employee of THOMSON, and I hold the position of Patent Administration Manager.

I am responsible for providing our patent counsel in foreign countries with the necessary
paperwork to file patent applications on behalf of THOMSON in their respective foreign
countries.

3. In the course of my duties, I worked with Isabelle Thibaudeau, in attempting to obtain signed Declarations from the inventor for U.S. Application Serial No. 10/533,848.

4. In addition to the attempts to contact the non-signing inventors via regular postal mail made by Isabelle Thibaudeau, I attempted to contact the non-signing inventors via their former/current employer, NDS. NDS is a company that many former Canal+ Technologies employees now work for. Our contact person at NDS is Frederique Durand. Note: Canal+ Technologies is the company from which THOMSON inherited intellectual property rights for the referenced application.

Application No.: 10/533,848 Docket No.: 11345/063001

5. I sent a first e-mail to Frederique Durand on April 13, 2006, in an attempt to obtain signed formal papers from the non-signing inventors. (See Tab 1). I included the Declaration and the Assignment documents as attachments to the e-mail. In the first e-mail, I requested Frederique Durand to indicate if any of the non-signing are no longer employed with NDS and, if so, to forward any contact information for such inventors to me. I received no response from Frederique Durand.

- 6. On April 21, 2006, I sent a second email to Frederique Durand at NDS, reminding her of the urgency in obtaining signatures from the non-signing inventors. I subsequently received an email from Frederique Durand informing me that she could not service my request until the beginning of May 2006, and that only 2 of the 3 non-signing inventors are currently employed by NDS. Particularly, inventor Hélène Bouilloux-Lafont is not employed by NDS, but inventors Axel Taldir and Franck Bachet are currently employees of NDS. (See Tab 1).
- I was not able to contact inventors Axel Taldir and Franck Bachet directly at NDS
  because NDS only allows their Human Resources department to contact employees
  directly.
- I did not receive any contact information for Héléne Bouilloux-Lafont from NDS nor am
   I aware of any other contact information for Héléne Bouilloux-Lafont.
- 9. I did not receive any executed documents from Axel Taldir and Franck Bachet in response to the reminder email I sent to Frederique Durand on May 12, 2006 (See Tab 1).
- 10. Upon sending an email to NDS regarding other THOMSON matters, I was informed by Frederique Durand on June 6, 2006, that the new Human Resources Director for NDS is Mr. Cédric Ros and that his email address is cros@nds.com (See Tab 1).

Application No.: 10/533,848 Docket No.: 11345/063001

11. I subsequently sent an email to Cédric Ros on June 9, 2006, including the Application as filed with the USPTO, the Declaration, and the Assignment documents. I have not received any follow-up response or any executed documents from Mr. Ros.

12. I forwarded the information detailing attempts to contact each of the non-signing inventors to our foreign associates in the United States, at Osha • Liang LLP on May 16, 2006, and June 12, 1006. (See Tab 2).

I, Frédérique Dersoir, hereby declare that all statements made herein of my own knowledge are true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Signed this day 14, of June 2006.

Frédérique Dersoir

From:

Dersoir Frederique [frederique.dersoir@thomson.net]

Sent:

Friday, June 09, 2006 8:56 AM

To: Subject: cros@nds.com FW: CPT02020

Attachments:

DeclarationCPT02020.pdf; CPT02020RevAssignment.pdf; DOC (14).pdf.zip; CPT02020

Application.pdf









DeclarationCPT CPT02020Rev DOC CPT02020 2020.pdf (71 KBignment.pdf (26).pdf.zip (112 klication.pdf (1 M

Bonjour Monsieur,

Suite à mon email du 8 juin 2006, je vous prie de bien vouloir trouver ci-après copie du message adressé à Mme Durand le 13 avril 2006 pour la demande de brevet CPT02020. Vous voudrez bien trouver, annexés à la présente, copie des documents de cession et déclaration ainsi qu'une copie de la demande de brevet telle que déposée aux Etats-Unis. Je vous remercie de transmettre ces documents aux inventeurs et me retourner en urgence les documents de cession et déclaration dûment revêtus de la signature des inventeurs. Merci par avance de votre aimable collaboration.

Veuillez agréer, Monsieur, l'expression de mes sincères salutations.

Frédérique DERSOIR
THOMSON
European Patent Operations
46 Quai A. Le Gallo
F-92648 Boulogne Cedex
Tél: +33 1 41 86 52 70 / F

Tél : +33 1 41 86 52 70 / Fax : +33 1 41 86 56 33 email :

<mailto:frederique.dersoir@thomson.net> frederique.dersoir@thomson.net

From: Dersoir Frederique

Sent: Thursday, April 13, 2006 11:29 AM

To: Durand, Frederique

Cc: Kohrs Martin; Andrau Philippe

Subject: CPT02020

Demande de brevet intitulée : SELECTING ADVERTISEMENT ON A SET TOP BOX IN A TELEVISION NETWORK"

Inventeurs : Franck BACHET, Hélène BOUILLOUX-LAFONT, Axel TALDIR, Olivier BISTER

Bonjour Madame,

Concernant la demande de brevet ci-dessus référencée, nous venons de recevoir une notification de l'Office Américain des Brevets nous invitant à leur retourner dans les meilleurs délais les documents de cession et déclaration. En effet, la pétition que nous avions engagée auprès de l'USPTO a été refusée pour insuffisance d'éléments mis en oeuvre pour contacter les inventeurs.

Afin de ne pas mettre en péril la demande, nous vous adressons des nouveaux documents dûment révisés et vous remercions de nous les retourner après avoir obtenu la signature des inventeurs, pour le 24 avril prochain.

Déclaration : Signatures requises pages 3 et 4

Assignment : Signatures requises page 1 (+ 2 témoins page 2)

DOC (14) : Signature requise page 2

Nous vous remercions de nous informer si certains de ces inventeurs ont quitté la société et le cas échéant nous indiquer leurs coordonnées. En vous remerciant par avance,

Cordialement

Frédérique DERSOIR THOMSON European Patent Operations 46 Quai A. Le Gallo F-92100 Boulogne-Billancourt Tél : + 33 1 41 86 52 70 / Fax : +33 1 41 86 56 33

email : frederique.dersoir@thomson.net

#### **DERSOIR Frederique**

From:

Dr Frederique

Sent:

Friday, June 09, 2006 3:56 PM

To:

'cros@nds.com' FW: CPT02020

Subject : Attachments :

DeclarationCPT02020.pdf; CPT02020RevAssignment.pdf;

DOC (14).pdf.zip; CPT02020Application.pdf

Dear Sir,

Further to my email of June 8, 2006, I thank you to find hereafter copy of the message forwarded to Mrs Durand on April 13, 2006 concerning patent application CPT02020.

You will find herewith enclosed, copy of assignment and declaration forms as well as copy of patent application such as filed in US.

I thank you to hand over these documents to inventors and to return urgently assignment and declaration forms to me duly signed by inventors

Thank you in advance for your kind cooperation.

Sincerely yours

Frédérique DERSOIR THOMSON European Patent Operations 46 Quai. A. Le Gallo F-92100 Boulogne-Billancourt

Tél: +33 1 41 86 52 70 / Fax: +33 1 41 86 56 33 email:

frederique.dersoir@thomson.net

From: Dersoir Frederique

Sent: Thursday April 13, 2006: 11:29

To: 'Durand, Frederique'

CC: Kohrs Martin; Andrau Philippe

Subject: CPT02020

Patent application entitled: SELECTING ADVERTISEMENT ON A SET TOP BOX IN A TELEVISION NETWORK"

Inventors: Franck BACHET, Hélène BOUILLOUX-LAFONT, Axel TALDIR,

Olivier BISTER

#### Dear Madam,

Referring to the above-mentioned patent application, we have now received a notification from the US Patent Office inviting us to return assignment and declaration forms as early as possible. The petition we had filed with US Patent Office was indeed dismissed for lack of elements used to contact inventors. In order not to jeopardize the application, we enclose herewith new revised documents and thank you to return them to us after obtaining inventors' signature by April 24, next.

Declaration: Signatures requested pages 3 and 4

Assignment: Signatures requested page 1 (+ 2 witnesses page 2)

DOC (14): Signature requested page 2

We thank you to inform us if some of the inventors have left the company and indicate in that case their address and phone number.

We thank you in advance

Regards
Frédérique DERSOIR
THOMSON
European Patent Operations
46 Quai. A. Le Gallo
F-92100 Boulogne-Billancourt

Tél: +33 1 41 86 52 70 / Fax: +33 1 41 86 56 33

email: frederique.dersoir@thomson.net

# Frédérique Dersoir

From: Durand, Frederique [mailto:FDurand@nds.com]

Sent: Tuesday, June 06, 2006 8:00 PM

To: Dersoir Frederique Subject: RE: CPT02011

#### Bonsoir

Je vous prie de noter que le nouveau DRH France de NDS est Cédric Ros (cros@nds.com)

Cordialement

Frédérique Durand Vice President & Chief Human Resources Officer NDS Group

65, rue Camille desmoulins 92442 Issy-les-Moulineaux cédex France +33 1 55 00 59 00 From : Durand, Frederique [mailto : FDurand@nds.com] Sent : Tuesday, June 06, 2006 : 8:00 PM

To: Dersoir Frédérique Subject: RE: CPT02011

# Good Evening,

I thank you to note that NDS'new Director Human Resources France is Cédric Ros (cros@nds.com) Regards

Frédérique Durand

Vice President & Chief Human Resources Officer NDS Group

65, rue Camille desmoulins 92242 Issy-les-Moulineaux cédex France +33 1 55 00 59 00

RE: CPT02020 Page 1 of 3

#### Seema Mehta

From: Dersoir Frederique [frederique.dersoir@thomson.net]

Sent: Friday, May 12, 2006 9:18 AM

To: Durand, Frederique Subject: RE: CPT02020

Bonjour Madame,

Je vous remercie de me confirmer que les documents ont bien été retournés.

Cdlt

Frédérique DERSOIR THOMSON European Patent Operations 46 Quai A. Le Gallo F-92100 Boulogne-Billancourt

Tél: +33 141 86 52 70 / Fax: +33 141 86 56 33

email: frederique.dersoir@thomson.net

-----Message d'origine-----

De : Durand, Frederique [mailto:FDurand@nds.com]

Envoyé: vendredi 21 avril 2006 10:56

À : Dersoir Frederique

Cc: Kohrs Martin; Andrau Philippe

Objet: Re: CPT02020

\_\_\_\_\_\_

Je n'ai pas recu votre e mail du 13 mars, ne suis pas en mesure de gérer votre demande avant la semaine du 1er mai, et n'ai que 2 des 4 inventeurs dans mon effectif (bachet et taldir).

Sent from my BlackBerry Wireless Device

----Original Message----

From: Dersoir Frederique <frederique.dersoir@thomson.net>

To: Durand, Frederique <FDurand@nds.com>

CC: Kohrs Martin <martin.kohrs@thomson.net>; Andrau Philippe <philippe.andrau@thomson.net>

Sent: Fri Apr 21 09:42:20 2006

Subject: TR: CPT02020

Madame,

Suite à mon message ci-dessous, je me permets d'attirer votre attention sur l'importance et l'urgence de cette affaire.

Passé ce délai, il ne sera plus possible de maintenir cette demande aux Etats-Unis.

Je vous remercie par avance de me tenir informée de l'évolution de cette affaire.

Cordialement

From:

DERSOIR Frédérique

Sent:

Friday, May12, 2006 9:18 AM

To:

"Durand, Frederique"

Subject:

CPT02020

# Good morning,

Thank you for acknowledging that these documents were returned.

Sincerely,

Frédérique DERSOIR THOMSON European Patent Operations 46 Quai A. Le Gallo F-92648 Boulogne Cedex

Tel: +33 1 41 86 52 70 / Fax: +33 1 41 86 56 33 email: frederique.dersoir@thomson.net

From: Dersoir Frederique [frederique.dersoir@thomson.net]

Sent: Friday, April 21, 2006 4:07 AM

To: Durand, Frederique

Cc: Andrau Philippe; Kohrs Martin

Subject: RE: CPT02020

Suite à votre email, merci de me retourner les documents la semaine du 1er mai afin que je puisse les réexpédier en urgence à nos agents américains.

Frédérique DERSOIR
THOMSON
European Patent Operations
46 Quai A. Le Gallo
F-92100 Boulogne-Billancourt
Tél : + 33 1 41 86 52 70 / Fax : +33 1 41 86 56 33
email : frederique.dersoir@thomson.net

-----Message d'origine-----

De : Durand, Frederique [mailto:FDurand@nds.com]

Envoyé : vendredi 21 avril 2006 10:56

À : Dersoir Frederique

Cc : Kohrs Martin; Andrau Philippe

Objet : Re: CPT02020

Je n'ai pas recu votre e mail du 13 mars, ne suis pas en mesure de gérer votre demande avant la semaine du 1er mai, et n'ai que 2 des 4 inventeurs dans mon effectif (bachet et taldir).

\_\_\_\_\_\_

Sent from my BlackBerry Wireless Device

----Original Message----

From: Dersoir Frederique <frederique.dersoir@thomson.net>

To: Durand, Frederique <FDurand@nds.com>

CC: Kohrs Martin <martin.kohrs@thomson.net>; Andrau Philippe <philippe.andrau@thomson.net>

Sent: Fri Apr 21 09:42:20 2006

Subject: TR: CPT02020

Madame,

Suite à mon message ci-dessous, je me permets d'attirer votre attention sur l'importance et l'urgence de cette affaire. Passé ce délai, il ne sera plus possible de maintenir cette demande aux Etats-Unis. Je vous remercie par avance de me tenir informée de l'évolution de cette affaire. Cordialement

Frédérique DERSOIR
THOMSON
European Patent Operations
46 Quai A. Le Gallo
F-92100 Boulogne-Billancourt
Tél : + 33 1 41 86 52 70 / Fax : +33 1 41 86 56 33 email : frederique.dersoir@thomson.net

De : Dersoir Frederique

Envoyé : jeudi 13 avril 2006 11:23

À : 'Durand, Frederique'

#### **DERSOIR Frederique**

From:

Dersoir Frederique

Sent:

Friday April 21 2006 11:07

To:

'Durand, Frederique'

CC:

Andrau Philippe; Kohrs Martin

Subject:

Re: CPT02020

Further to your email, thank you for sending documents back to me week of May 1<sup>st</sup>, so that I may forward them back urgently to our US agents

Frédérique DERSOIR

**THOMSON** 

**European Patent Operations** 

46 Quai. A. Le Gallo

F-92100 Boulogne-Billancourt

Tél: +33 1 41 86 52 70 / Fax: +33 1 41 86 56 33 email:

frederique.dersoir@thomson.net

----Original Message----

From: Durand, Frederique [mailto: FDurand@nds.com] Sent: Friday April 21 2006

10:56

To Dersoir Frederique CC: Kohrs Martin; Andrau Philippe Subject: Re:

CPT02020

I have not received your e mail of March 13, am not in position to handle your request before week of May 1<sup>st</sup>, and have only 2 out of 4 inventors in my members (bachet and taldir).

Sent from my Blackberry Wireless Device

----Original Message----

From : Dersoir Frederique <frederique.dersoir@thomson.net>

To: Durand, Frederique < FDurand@nds.com >

CC: Kohrs Martin <martin.kohrs@thomson.net>; Andrau Philippe

<philippe.andrau@thomson.net>
Sent : Fri Apr 21 09:42:20 2006

Subject: TR: CPT02020

Madam,

Further to my message below, please let me draw your attention on the importance and urgency of this matter.

After the deadline, it will be no longer possible to maintain this application alive in the United States.

I thank you in advance to keep me informed on progress of this matter.

From:

Dersoir Frederique [frederique.dersoir@thomson.net]

Sent:

Monday, June 12, 2006 7:50 AM

To:

Seema Mehta

Cc:

Aly Z. Dossa

Subject:

RE: CPT02020 documents from NDS (11345.063001)

Attachments:

FW: CPT02011; FW: CPT02020; CPT02020TRANLSATION1.doc.zip;

CPT02020TRANLSATION2.doc.zip

M







FW: CPT02011 FW: CPT02020 CPT02020TRA CPT02020TRA ATION1.doc.zipATION2.doc.zip

Dear Seema,

As indicated last week, please find herewith enclosed copy of my last correspondence to NDS.

The first email referenced CPT02011 is a general email to new NDS Human Resources contact (as per Frédérique Durand's instructions). + English translation CPT02020TRANSLATION1.DOC

The second email referenced CPT02020 is our final reminder to NDS for CPT02020 (which included copy of US application) + English translation CPT02020TRANSLATION2.DOC

I wish you good receipt of these documents.

With my best regards

Frédérique

----Original Message----From: Dersoir Frederique

Sent: Friday, June 09, 2006 5:45 PM

To: 'Seema Mehta' Cc: Aly Z. Dossa

Subject: RE: CPT02020 documents from NDS (11345.063001)

Dear Seema,

Please be confirmed that I have duly sent a new email to NDS including copy of US application.

I am preparing the English translation and will forward it to you next Monday. Best regards

Frédérique

----Original Message----

From: Seema Mehta [mailto:Mehta@oshaliang.com]

Sent: Thursday, June 08, 2006 5:06 PM

To: Dersoir Frederique

Cc: Aly Z. Dossa

Subject: RE: CPT02020 documents from NDS (11345.063001)

Frederique:

Please find attached the Application to forward to NDS. Also, please provide us with the translations for any emails you send to NDS.

Thank you in advance.

Best Regards, Seema Mehta

From:

Dersoir Frederique [frederique.dersoir@thomson.net]

Sent:

Tuesday, May 16, 2006 1:30 AM

To:

Seema Mehta

Subject:

RE: CPT02020 documents from NDS (11345.063001)

Attachments: RE: CPT02020

#### Dear Seema.

Unfortunately I have not received any papers from NDS and sent a reminder to Frederique DURAND last Friday to which I received no answer until now.

Here is a copy of my reminder. I'll keep you informed of any further progress.

Best regards

#### Frédérique

**De :** Seema Mehta [mailto:Mehta@oshaliang.com]

Envoyé: mardi 16 mai 2006 00:31

À : Dersoir Frederique

Cc: Aly Z. Dossa; Debra V. Wieser

**Objet:** CPT02020 documents from NDS (11345.063001)

#### Frederique:

Have you received any information from NDS for inventors BACHET and TALDIR?

If not, please follow-up with Frederique Durand and provide us with the proof of emails to NDS as soon as possible.

Best Regards.

# Seema Mehta Patent Agent OSHA · LIANG LLP www.oshaliang.com

713.228.8600 (Voice) 713.228.8778 (Fax)

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